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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,892	09/22/2003	Christian Wulff	PF51063-03	4266
26474	7590	05/10/2004	EXAMINER	
KEIL & WEINKAUF 1350 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			SHIAO, REI TSANG	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/664,892

Applicant(s)

WULFF ET AL.

Examiner

Robert Shiao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on application filed on 9/22, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3 and 26-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 and 26-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/368,577.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>0504</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This application claims benefit of the foreign application:

GERMANY 19962601.4 with a filing date 12/23, 1999.

2. Claims 3 and 26-38 are pending in the application.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3 and 26-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter "Y is a radical which is readily exchangeable for H", which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, see claim 3, line 6.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 28, line 1, recites the limitation "wherein step (a)", which is insufficient antecedent basis for this limitation in the claim. The limitation "wherein step (a)" is not found in the base claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Dever et al. US 3,459,837.

Applicants claim a process of making triacyl phosphite compounds of formula (III),  $P(OCOR^3)_3$ , by reacting carboxylic acid compounds of formula (IV) or its salt,  $R^3COOH$ , with phosphorus trihalide. This process is found in the pages 6-7 of the instant specification.

Dever et al. disclose a process of making phosphite compounds, i.e.,  $P(OCCH_3)_3$ , by reacting phosphorus trihalide with carboxylic acid salt, see columns 1-4, specifically lines 60-72, scheme I of column 1. Dever et al. processes clearly anticipate the instant

processes, wherein triacyl phosphite ( $R^3$  is methyl) compounds, i.e.,  $P(OCCH_3)_3$ , are

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prepared by reacting carboxylic acid compounds salt (i.e,  $\text{CH}_3\text{COONa}$ ) with phosphorus trihalide.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dever et al. US 3,459,837.

Applicants claim a process of making triacyl phosphite compounds of formula (III),  $\text{P}(\text{OCOR}^3)_3$ , by reacting carboxylic acid compounds of formula (IV) or its salt,  $\text{R}^3\text{COOH}$ , with phosphorus trihalide. This process is found in the pages 6-7 of the instant specification.

**Determination of the scope and content of the prior art (MPEP §2141.01)**

Dever et al. disclose a process of making triacyl phosphite compounds, i.e.,

$\text{P}(\text{OCCH}_3)_3$ , by reacting phosphorus trihalide with carboxylic acid salt, see columns 1-4, specifically lines 60-72, scheme I of column 1.

**Determination of the difference between the prior art and the claims (MPEP §2141.02)**

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The difference between the instant claims and Dever et al. is that the instant claims silence the anhydrous reaction condition, while Dever et al. processes are operated under anhydrous condition.

**Finding of prima facie obviousness-rational and motivation (MPEP §2142-2143)**

One having ordinary skill in the art would find the instant claims prima facie obvious **because** one would be motivated to employ the processes of Dever et al. to obtain a compound of formula (III), wherein triacyl phosphite compound of formula (III) are prepared by reacting phosphorus trihalide with carboxylic acid compounds of formula (IV) or its salt.

The motivation to make the claimed processes derives from the expectation that the instant claimed processes derived from known Dever et al. processes and would possess similar yields to that which is claimed in the reference.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



for

Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626



Robert Shiao, Ph.D.  
Patent Examiner  
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May 6, 2004